IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

\pplicants	:	P. Hamilton Clark et al.	)	Examiner:
			)	Johnna R. Stimpak
Serial No.	:	09/950,087	)	
			)	Art Unit:
Cnfrm. No.	:	2257	)	3623
			)	
Filed	:	September 10, 2001	)	
			)	
For	:	ELECTRONIC PROJECT MANAGEMENT	)	
		SYSTEM USING PROJECT PHASES	)	
			)	

REQUEST FOR PRE-APPEAL BRIEF CONFERENCE

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Applicant hereby requests formal review of the April 19, 2006, final office action, because the Examiner fails to identify the presence of essential elements required to establish a *prima facie* case of anticipation.

This paper is being filed concurrently with a Notice of Appeal and the requisite fee, as required in the guidelines for the New Pre-Appeal Brief Conference Pilot Program published in the July 12, 2005, Official Gazette Notice.

In the final office action, the Examiner maintained the rejection of Claims 1-5, 7-11, 13-17, 19-21, 23-25 and 27-29 under 35 U.S.C. 102(b), on the grounds that they were allegedly considered to be anticipated by the McAtee et al. patent (U.S. Patent No. 5,301,320). As set forth in MPEP § 2131, "to anticipate a claim, the reference <u>must</u> teach every element of the claim" (emphasis added). For reasons presented below, it is respectfully submitted that the McAtee et al. patent does not teach every element of the rejected claims, and therefore does not meet the standard of anticipation of those claims.

On pages 10-12 of the response filed on February 1, 2006, Applicants pointed out that the parts of the McAtee et al. patent relied upon in the November 4, 2005, action (i.e., column 5, lines 25-30 and column 7, lines 17-33) do not describe, either explicitly or inherently, claimed processes including "identifying which of one or more stored exit criteria are applicable to at least one of the phases of the project," as recited in independent claims 1, 13, 19 and 27, and claimed systems including an "identification system that identifies which of one or more stored exit criteria are applicable to at least one of the phases of the project," as recited in independent claims 7 and 23. The Examiner does not consider these arguments convincing, for reasons given in the "Response to Arguments" section of the final action. However, these reasons provided by the Examiner are broad, conclusory, and unsubstantiated statements that do not address the specific claimed features discussed in Applicants' response. For example, the Examiner asserts:

> Applicant argues that McAtee et al. does not teach identifying one or more exit criteria that are applicable to at least one of the phases of the project. However, Examiner points to column 6, lines 7-61, wherein it is taught that the user interacts with the manager utility to enter key information pertaining to each goal. This information is entered into a data structured, stored and later used to create various computer programs that facilitate or actually carry out the tasks. Therefore, McAtee et al. does teach that the goals and criteria applicable to the tasks are stored to be later retrieved when building the computer programs. (See, lines 2-9 of section 3, at page 2.)

Applicants respectfully traverse these statements and any other allegation that the McAtee et al. patent describes that which is claimed. First, it is to be pointed out that Applicants did not argue "McAtee et al. does not teach identifying one or more exit criteria that are applicable to at least one of the phases of the project," as alleged by the Examiner. Rather, Applicants' response presented arguments that McAtee et al. "does not disclose the features of 'identifying which of one or more stored exit criteria are applicable to at least one of the phases of the project'" (further emphasis added) (see, lines 25-30 of page 10 of the February 1st response) because, in contrast to the claimed invention, the McAtee et al. system involves a designer conceptualizing a workflow decomposition and creating a workflow template by way of interaction with a Manager Utility component (see, line 12-24 of page 10).

Second, it appears that the Examiner, having realized that the parts of McAtee et al. previously cited do not describe what is claimed, now contends that column 6, lines 7-61 describes claimed features relating to identifying which of one or more stored exit criteria are applicable to at least one of the phases of the project. It is respectfully submitted,

however, that the newly cited part of McAtee et al. does not teach the features recited in claims 1, 13, 19 and 27 of "identifying which of one or more stored exit criteria are applicable to at least one of the phases of the project," and the features recited in claims 7 and 23 of "identification system that identifies which of one or more stored exit criteria are applicable to at least one of the phases of the project." Rather, the newly cited section of McAtee et al. relates to a designer entering key information data (i.e., entering goals and goal information into various fields) to create a "workflow definition database," and "creating various computer programs (i.e., SWAs and CMAs) that facilitate or actually carry out these tasks" (column 6, lines 59-61).

The Examiner's assertion that McAtee teaches "goals and criteria applicable to the tasks are stored to be later retrieved when building the computer programs," is too general and thus does not disclose the specific claimed features relating to identifying which of one or more stored exit criteria are applicable to at least one of the phases of the project. Furthermore, because a designer utilizing the McAtee et al. system identifies goals/tasks on the fly using the M/U prior to the creation of any program that carries out these goals/tasks (i.e., while creating the workflow definition database), even if these goals/tasks are retrieved at some later time to create a computer program, it is not by way of identifying which of one or more stored exit criteria are applicable, as claimed. Indeed, McAtee et al. discloses, at column 4, lines 4-18 and column 10, lines 7-14, that WIP-processing programs written by the designer (referred to as "software agents" (SWAs)) are associated with a name of a goal and scheduled by and executed under the control of Controller and Controller Services Interface (CSI) components, which process WIPs directly through the workflow activities as directed by the template constructed by the designer using the M/U. Furthermore, it would appear that a predefined goal or task would serve as a starting point for the designer at the time he or she creates an SWA for that goal/task and associates the name of the goal/task with that SWA. At that time, however, all the goals/tasks had been previously identified and set by the designer using the M/U. Hence, there would no apparent need in McAtee et al. system to perform a process of identifying which one or more stored exit criteria are applicable to at least one phase of a project when creating computer programs (i.e., SWAs). Accordingly, the Examiner's allegations concerning retrieval of stored tasks are not relevant to the combinations of specific features set forth in the independent claims.

Differences between the claimed invention and the system described McAtee et al. patent are further brought out in the next recited process in claims 1, 13, 19 and 27 of "establishing <u>the identified one or more exit criteria for the at least one phase</u> ... ." This process refers back to the process of "identifying which of one or more exit criteria are applicable ...." An analogous analysis exist with respect to subject matter recited in claims 7 and 23 in the context of system components. In connection with these features, the Examiner refers to column 5, lines 45-50, which describes a process performed by the designer to form relationships between tasks to create one or more compound goals. However, these relationships are created by the designer when conceptualizing a workforce description and entering it using a Manager Utility (M/U) (see, column 5, line 67 to column 6, line 3). More particularly, McAtee et al. describes that compound goals such as those shown in FIG. 2 (e.g., "process order" 9 and "final check 23, goals 18a, 18b and 18c) are constructed by the designer by way of data field entry using the M/U by entering goals as a series of boxes or as a sequence of commands (column 6, lines 51-59). Hence, the processes described in McAtee et al. relating to compound goals do not involve identifying which of one or more <u>stored exit criteria</u> are applicable to at least one of the phases of the project, as claimed.

For at least these reasons, it is respectfully submitted that the above statements reproduced from the final office action do not demonstrate where the McAtee et al. patent describes, either explicitly or inherently, every feature set forth in each of the claim 1, 7, 13, 19, 23 and 27 combinations, and hence also in the dependent claims. Absent such a showing, the pending Section 102 rejection is improper and should be withdrawn.

The Examiner also maintained the rejection of claims 6, 12, 18, 22, 26 and 30 under 35 U.S.C. § 103, as allegedly being unpatentable over McAtee et al. However, these claims depend from one of independent claims 1, 7, 13, 19, 23 and 27, and are therefore allowable at least for the reasons pointed out above, and further for the combinations including additional points of distinction set forth by the additional features recited. Also, the McAtee et al. patent provides no suggestion or hint of the concept of identifying which of one or more exit criteria from stored criteria are applicable to one or more phases of a project, as pointed out above with respect to the independent claims. Even if one were to assume, for the sake of argument, that the Examiner may be proposing modifications to the system of McAtee et al. to meet the combinations of each and every claim limitation, the McAtee et al.

patent not only fails to suggest these modifications, but any such change would require altering the principal operation of the McAtee et al. system. Hence, the Examiner fails to establish a *prima facie* case of obviousness on several levels with respect to independent claims 1, 7, 13, 19, 23 and 27, and thus also claims 6, 12, 18, 22, 26 and 30. See MPEP § 2143.01.

Furthermore, the subject matter set forth in Applicants' claims facilitates advantageous features not provided to a designer utilizing the system of McAtee et al. to conceptualizing and inputting goals and tasks in a workflow template. For example, the claimed invention allows for selecting from ideas and lessons of others captured from previous projects and available to users within or across teams. Hence, the subject matter set forth in the pending claims defines a <u>significant</u> departure from the methods and system described in the McAtee et al. patent.

Finally, on page 2 of the Advisory Action dated July 12, 2006, the Examiner asserts that column 5, lines 5-50 of McAtee teaches "a designer breaking down <u>the stored business operations</u> into a series of goals" (emphasis added). This is simply not so. There is no mention whatsoever of "stored business operations" in the cited part of the McAtee patent, much less the actual claimed features of related to <u>stored exit criteria</u>.

In view of all of the foregoing, Applicants respectfully submit that all pending rejections are improper and should be withdrawn. Notification of allowance without further delay is earnestly sought.

Respectfully submitted,

Date: July 19, 2006   /John F. Guay, Reg.# 47248/
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